

Doc Code: AP.PRE.REQ

PTO/SB/33 (07/05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR</p> <p>on <u>April 3, 2006</u></p> <p>Signature <u><i>V. S. Leliever</i></u></p> <p>Typed or printed name <u>Veronika S. Leliever</u></p>		Application Number	Filed
		09/540,035	March 31, 2000
		First Named Inventor	
		Jay S. WALKER	
Art Unit		Examiner	
3628		POINVIL, Frantzy	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>54,096</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p><u><i>Carson C.K. Fincham</i></u> Signature Carson C.K. Fincham Typed or printed name <u>(203) 461-7017</u> Telephone number <u>April 3, 2006</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

<input checked="" type="checkbox"/> *Total of <u>3</u> forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



CUSTOMER NO. 22927

Applicants: Walker *et al.*
Application No.: 09/540,035
Filed: March 31, 2000
Title: RETAIL SYSTEM FOR SELLING PRODUCTS BASED ON A
FLEXIBLE PRODUCT DESCRIPTION

Attorney Docket No.: 99-063

Group Art Unit: 3628
Examiner: Frantzy Poinvil

**PRE-APPEAL BRIEF REQUEST FOR REVIEW
of the rejections in the Final Office Action mailed January 4, 2006**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Final Office Action mailed January 4, 2006. No amendments are being filed with this request and this request is being filed with a Notice of Appeal. Review is requested for the reasons set forth in the remarks beginning on the following page.

REMARKS

I. Introduction

Claims 5-6, 29, 31-34, 36-41, and 43-50 are currently pending in the present application. Claims 5, 29, 31-34, 36-41, and 43-50 are independent.

- Claims 5-6, 29, 34, and 41 are allowed.
- Claims 31-33, 36-40, and 43-50 stand rejected. In particular:

(A) claims 49-50 stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by U.S. Patent No. 5,732,398 (hereinafter "Tagawa"); and

(B) claims 31-33, 36-40, and 43-48 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Tagawa.

Applicants thank the Examiner for indicating that claims 5-6, 29, 34, and 41 are allowable. Applicants further respectfully traverse the grounds for rejection of claims 49 and 50, and claims 31-33, 36-40, and 43-48, as follows.

II. The Examiner's Rejections

A. Rejections under §102(b)

Claims 49-50 stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by Tagawa. Applicants traverse this ground for rejection as follows.

The Examiner simply fails to apply the cited reference to the limitations of claims 49-50. The Examiner makes broad, conclusory statements (Final Office Action, bullet three, pgs. 6-7) regarding the general teachings of Tagawa, yet fails to provide support for these statements and fails to directly address *any* of the limitations of claims 49-50.

For example, claims 49-50 recite, generally, receiving **two different product descriptions for the same product**, and, based on these descriptions, determining **two different prices for the same product**. The Examiner does not address these features of claims 49-50 and does not make any showing as to how Tagawa is believed to anticipate these features. Applicants have reviewed Tagawa and have found no teaching or suggestion that reads on the claimed limitations of claims 49-50.

Accordingly, as the Examiner has failed to show how all the limitations of claims 49-50 are taught by the cited reference, the Examiner has failed to set forth a *prima facie* case for anticipation. The §102(b) rejections of claims 49-50 should therefore be reversed.

B. Rejections under §103(a)

Claims 31-33, 36-40, and 43-48 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Tagawa. Applicants traverse this ground for rejection as follows.

The Examiner has admitted (Final Office Action, pg. 2, last paragraph) that Tagawa fails to teach the claimed limitations being conducted in the recited order. The Examiner believes, however, that the order of the process steps recited in the claims is obvious. *Id.* The Examiner states, for example, “the order of these functions is left to the individual business person having a desire to operate his/her business in this manner. Such does not require any steps to be performed or does not limit the claim to a particular structure, and thus attributes to no patentable difference apart from Tagawa.” *Id.*, at pg. 3, last six lines.

Applicants respectfully note that this broad assertion by the Examiner falls far short of the substantial evidence required to support a *prima facie* case for obviousness. The Examiner does not, for example, point to any specific teaching or suggestion that would have motivated one of ordinary skill in the art to modify Tagawa to conduct the steps in the order recited.

The Examiner further states, apparently in support of the un-supported motivation to modify Tagawa, that there is no clear or significant advantage in changing the order of the steps in Tagawa to read on the claimed embodiments. Initially, Applicants note that examples and descriptions of the potential advantages of the claimed embodiments may be found *throughout* Applicants’ specification as filed. Further, the Examiner’s reasoning appears contrary to the Examiners’ allegation that the alteration of the steps in Tagawa would have been obvious. Why, for example, if there is no clear advantage to modifying the order of the steps in Tagawa to read on the claimed order of steps, would one have

been motivated to modify Tagawa? Without any evidence or reasoned explanation to the contrary, it appears that one would certainly *not* have been motivated to modify Tagawa.

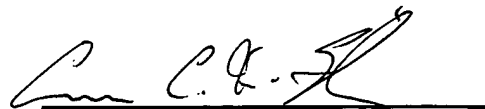
Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness at least because the Examiner has not shown that the cited reference teaches the claimed limitations in the recited order, nor pointed to any motivation that would have led one skilled in the art to make the proposed modifications to the cited reference. The §103(a) rejections of claims 31-33, 36-40, and 43-48 should therefore be reversed.

III. Conclusion

At least for the foregoing reasons, it is submitted that all claims are clearly in condition for allowance and Pre-Appeal Brief Review is requested to avoid the unnecessary expense of preparing an Appeal Brief in relation to the current rejections.

If there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via e-mail at cfincham@walkerdigital.com, at the Examiner's convenience.

Respectfully submitted,



Carson C.K. Fincham
Attorney for Applicants
Registration No. 54,096
Walker Digital, LLC
cfincham@walkerdigital.com
203-461-7017 /voice
203-461-7018 /fax

April 3, 2006
Date